

09/710,342  
Art Unit 2876  
8884.00

Claim	Location of Support
1	Page 6, lines 7 - 9
8, 9	Page 3, lines 5 - 12
21 - 23	Page 3, lines 5 - 12 and 18 - 23

Other claims were amended, but no support is required for those amendments.

#### **Response to 102 - Rejections**

Claims 1 - 3, 6 - 14, and 17 - 20 were rejected on grounds of anticipation, based on Gatto.

#### Claim 1

Amended claim 1 states that all indicators are of different shape. Gatto does not show that.

Further, claim 1 states that each indicator is associated with a pre-defined transaction. Gatto does not show such a group of indicators, all of different shape, and each associated with a pre-defined transaction.

Further still, claim 1 states that selection of an indicator causes execution of the associated transaction. Gatto does not show such a group of indicators, all of different shape, each associated with a pre-defined transaction, wherein selection of an indicator causes execution of the associated transaction.

This applies to the claims depending from claim 1.

09/710,342  
Art Unit 2876  
8884.00

Claim 10

Claim 10 recites:

10. A self-service terminal comprising:
- a user-interface consisting essentially of a plurality of
- (1) indicators which are all different in size, shape, color, texture, or a combination thereof,
  - (2) an identifier, and
  - (3) a dispensing area.

Applicant points out that this claim is of the "consisting essentially of" type. Gatto's Figure 1 clearly shows a user interface containing more elements than those recited. For example, he shows keypad 14, which contains keys which are all identical in shape. Claim 10 recites that the "indicators" are all different in shape.

Thus, claim 10 does not read on Gatto.

In addition, claim 1 is not shown in Gatto for a different reason. Claim 1 states ". . . so that a user may execute a desired transaction by selecting a single indicator." Gatto does not show that.

Gatto requires multiple button presses. First, the user must select whether to use the "custom menu" or the standard menu.

09/710,342  
Art Unit 2876  
8884.00

(Figure 2, beginning with block 104; column 7, lines 19, 11.)

In fact, Gatto states that his system "Minimizes the number of selections/key entries a user must perform . . ." (Column 7, lines 37, 38.) If he required a **single** key entry, he would not have said that. He would have said, "Requires only a single key."

Applicant points out that Gatto, column 7, line 45 et seq., states that a given menu may be displayed automatically. However, the user must select that operation, by pressing buttons. That is not a single key entry.

Therefore, Applicant submits that Gatto does not anticipate the claims discussed above. MPEP § 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

#### **Response to 103 - Rejections**

Claims 4, 5, 15, and 16 were rejected as obvious, based on Gatto and Wheeler. Of these claims, only claims 4 and 5 are now pending.

#### Even if References are Combined, Claims not Found

Applicant points out that, even if the references are combined, claims 4 and 5 are not found. A primary reason is that

09/710,342  
Art Unit 2876  
8884.00

Wheeler does not show buttons which are **all different**.<sup>1</sup> For example, Wheeler's Figure 12 shows some differently shaped buttons, but many buttons are identical in shape.

Restated, Wheeler shows three shapes in that Figure (circle, square, and diamond), but shows 14 buttons. Plainly, some shapes must be repeated (such as in buttons 4 and 6, which are both squares).

Therefore, Applicant submits that, even if the references are combined, claims 4 and 5 are not attained.

From another point of view, Gatto's Figure 1 appears to show 28 buttons. Wheeler does not show 28 different shapes. Therefore, even if the references are combined, the claim recitation is not met.

From yet another point of view, it is probably impossible to attain the claim recitations by combining the references. As a minimum, the PTO must show 28 different shapes, to use in Gatto. That has not been done.

#### No Teaching for Combining References

##### POINT 1

The rationale given for combining the references is that

---

<sup>1</sup> Applicant points out that the PTO's assertion on page 4, section 7, third paragraph is thus not correct. Wheeler's buttons are not "unique" in shape and color. Some are the same shape.

09/710,342  
Art Unit 2876  
8884.00

adding differently colored buttons to Gatto helps a visually impaired person. (Office Action, page 4, last paragraph.)

Applicant points out that Wheeler states that assisting visually impaired persons in using keypads is one of his goals. (Page 1, third paragraph.) He mentions cash-dispensing machines as containing such keypads. (Page 1, line 12.)

However, application of Wheeler must be limited to (1) his express teachings, and (2) those clearly implied. Wheeler states that **adjacent** keys are different color or shape. (Page 3, bottom; page 4, second paragraph; page 18, lines 23 - 26.) He does not state that **all** keys are different in shape/color. Again, he only states that **adjacent** keys are different in color or shape. That does not lead to the claimed invention.

## POINT 2

Wheeler expressly states that his system preferably contains **both**

(1) a "control system" (of which the shaped keys are a part)

and

(2) a speech synthesis system.

(Page 7, lines 21 - 22. See also page 13, bottom.)

Therefore, Wheeler states that his invention lies in the

09/710,342  
Art Unit 2876  
8884.00

preceding pair of elements (control system and speech synthesis system). No teaching has been given for combining this pair with Gatto. References are read as a whole:

MPEP § 2141.03, last paragraph, states:

Prior art must be considered in its entirety, including disclosures that teach away from the claims.

#### POINT 3

In addition, combining this pair of elements with Gatto creates problems. If you combine Wheeler with Gatto, you would obtain

(1) a keypad in which **adjacent** keys are different in shape, but not all keys being different in shape

and

(2) a speech synthesis system, which identifies, in spoken form, the keys just pressed.

As explained above, element (1) is not what is claimed. As to (2), no teaching has been shown for combining the speech synthesis system with Gatto. And the speech system creates problems, identified below.

09/710,342  
Art Unit 2876  
8884.00

POINT 4

Wheeler states that ". . . speech terms may be entered by an end user." (Page 6, line 21.) If the "end user," namely, Gatto's visually impaired person, now enters the speech terms corresponding to the programmed buttons, which speech terms the (modified) Gatto is to now speak, then Gatto has been **completely re-designed**, contrary to the following MPEP sections.

MPEP § 2143.01, last paragraph, states:

If the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims prima facie obvious.

MPEP § 2143.01 also states:

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

POINT 5

In addition, as explained above, Wheeler provides audible feedback to the user. Applicant submits that common sense

09/710,342  
Art Unit 2876  
8884.00

prohibits this at an ATM.

Do you want your ATM to say this to you: "Madame Customer: Is it correct that you wish to withdraw \$ 500.00 in cash ?" No. ATM customers want their transactions to be kept secret.

#### Combination of References is Dubious

Applicant submits that the combination-of-references is highly dubious, for a different reason. Wheeler's goal is to assist visually impaired people, which plainly includes blind people.

Gatto states that a customer can generate a customized menu, which is stored in the customer's ID card, or otherwise associated with the customer. When the customer logs into the ATM, the ATM asks whether the customer wants to see (1) a normal menu or (2) the customized menu. (Column 9, bottom, column 10, top.)

These menus are displayed on Gatto's display 15, which is not numbered in his Figure 1, but is the rectangle containing the symbols "CT1," "CT2", and so on. (Column 7, line 21 et seq.)

Here is the problem. How does a blind person learn what the button next to the symbol "CT3" means ?

In order for the blind person to be assisted, (1) Wheeler-type keys must be added to Gatto and (2) the blind person must be somehow taught how to feel the keys, and what they mean.

But the latter has not been shown in the prior art. And it is not implied by Wheeler, because Wheeler uses spoken feedback to



09/710,342  
Art Unit 2876  
8884.00

identify the buttons pressed on the telephone of his Figure 12.

Therefore, the addition of Wheeler's keys to Gatto does not, by itself, assist the blind persons, unless they are taught how to use the keys. That has not been shown in the prior art. Wheeler's teaching is through audible feedback, but no teaching has been given of adding that to Gatto.

Combination doe not Follow In re Dembiczak

The PTO's rationale does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

- **objective evidence** of a teaching for combining references must be provided;
- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can act as a source;
- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;
- broad conclusory statements by the Examiner do not qualify as evidence; and

09/710,342  
Art Unit 2876  
8884.00

-- "particular factual findings" as to the teaching are required.

The PTO has not provided the required "evidence" for combining the two references.

#### **Added Independent Claims**

The added independent claims recite (1) buttons, all of different color/shape/size which (2) can be programmed by the customer. Even if the references are combined, that is not shown. One reason is that, as explained above, Wheeler only states that **adjacent** buttons should be different.

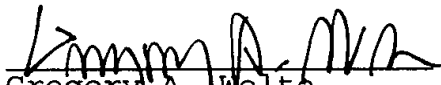
09/710,342  
Art Unit 2876  
8884.00

**Conclusion**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
Gregory A. Welte  
Reg. No. 30,434

NCR Corporation  
1700 South Patterson Blvd.  
WHQ - 5E  
Dayton, OH 45479  
June 11, 2002  
(937) 445 - 4956

WELTE DIRECT: (765) 296 - 4699

09/710,342  
Art Unit 2876  
8884.00

ATTACHMENT: Annotated Abstract and Claim(s) Showing Amendments

#### ABSTRACT

A self-service terminal (10) having a simplified user interface (20) [is described]. The user interface (20) [comprises] contains a plurality of indicators (28) for entering data, where each indicator (28) has a unique attribute, such as size, shape, color, surface texture, or the like. Each indicator is associated with a pre-defined transaction, so that a user may execute a desired transaction by selecting a single indicator (28). A method of executing a transaction is also described.

#### CLAIMS

1. A self-service terminal comprising:  
a user interface including a  
[plurality of indicators for entering data, each indicator having a unique attribute]  
group of indicators, all of different shapes and each indicator  
being associated with a pre-defined transaction so that a user may execute a desired transaction by selecting a single indicator.

2. [A] The terminal according to claim 1, wherein each indicator includes a push button.

09/710,342  
Art Unit 2876  
8884.00

3. [A] The terminal according to claim 1, wherein the indicator protrudes from a surface on which [it] the indicator is mounted.

4. [A] The terminal according to claim 1, wherein the unique attribute is related to [the] size of the indicator.

5. [A] The terminal according to claim 1, wherein the unique attribute is related to [the] color of the indicator.

6. [A] The terminal according to claim 1, wherein the pre-defined transaction is programmed by a user.

7. [A] The terminal according to claim 1, wherein the pre-defined transaction is programmed by the owner of the terminal.

8. A self-service terminal comprising:

a user interface including a plurality of indicators for entering data, each indicator being different to the other indicators in size, shape, color, or texture, or a combination thereof and being associated with a pre-defined transaction so that a user may

09/710,342  
Art Unit 2876  
8884.00

execute a desired transaction by selecting  
only one indicator.

9. A method of executing a transaction at a self-service terminal, the method comprising:

providing a plurality of indicators, each indicator having a unique attribute of size, shape, color, texture, or combination thereof;

associating a unique transaction with each indicator; and  
in response to a selection of one of the indicators, executing a transaction associated with the selected indicator.

10. A self-service terminal comprising:

a user-interface consisting essentially of a plurality of [different]

(1) indicators which are all different in size, shape, color, texture, or a combination thereof,

(2) an identifier, and

(3) a dispensing area.